

REMARKS

Claim 1-3 are pending in the application. Claim 1 is rejected. Claims 2 and 3 are withdrawn from consideration. Claims 1-3 are herein amended. No new matter is believed to have been entered through the various claim amendments. Further, upon belief, it is respectfully submitted that this paper is fully responsive to the outstanding Office Action.

Information Disclosure Statement

The Examiner notes that the IDSs filed on March 17, 2005 and November 14, 2005 fail to comply with the requirements of 37 C.F.R. 1.98(a)(2), because a copy of each cited foreign patent document has not been received. The IDSs cited JP9-120424A, JP8-190586A, JP8-69494A, and JP11-114784. These references were cited in the International Search Report.

Applicants file concurrently herewith an IDS containing a translation of the abstract of the cited reference.

The Examiner is respectfully requested to return an initialled and signed copy of Form PTO/SB/08a to thereby indicate that the items listed therein were considered by the Examiner.

Claim Rejections - 35 U.S.C. §103

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,919 to Brinkley et al in view of U.S. Patent Application Publication No. 2003/0130876 to Chen et al.

The rejection is respectfully traversed.

Claim 1 is herein amended to recite, “a system for computing an order quantity of parts constituting a product based on a production schedule of the product, comprising: a. required part quantity computing means for computing a required quantity of the parts based on the production schedule; b. actual inventory quantity checking means for checking an actual quantity of inventory of the parts; c. first part order quantity computing means for computing a first part order quantity for a predetermined first period of time based on the computed required quantity of the parts and the checked actual quantity of inventory of the parts; d. tentative inventory quantity computing means for computing a tentative quantity of inventory of the parts based on a past order record of the parts and a production record of the product; e. second part order quantity computing means for computing a second part order quantity for a predetermined second period of time, longer than the predetermined first period of time, based on the computed required quantity of the parts and the computed tentative quantity of inventory of the parts; f. price data inputting means for inputting a price data of the parts; g. part price data storing means for storing the inputted price data of the parts; h. standard price data inputting means for

inputting a standard price data to be compared with the inputted price data of the parts; i. standard price data storing means for storing the inputted standard price data; j. selecting means for comparing the inputted price data with the stored standard price data and for selecting the first part order quantity computing means when a value of the inputted price data is greater than a value of the stored standard price data, while for selecting the second part order quantity computing means when a value of the inputted price data is equal to or less than a value of the stored standard price data; and k. part ordering means for ordering the parts based on the part order quantity computed by the selected part order quantity computing means.” It is respectfully submitted that the cited art fails to teach or suggest, either alone or in combination, at least the aforementioned recitations of claim 1 of the present application.

(A) In the outstanding Office Action at page 3, the Office Action concedes that, “Brinkley does not explicitly disclose a required part quantity computing means; an actual inventory quality checking means; a first part order quantity computing means; and a second part order quantity computing means.”

On the next page, the Office Action contends that, “Chen, on the other hand, teaches a required party quantity computing means; an actual inventory quality checking means; a first part order quantity computing means; and a second part order quantity computing means.” The Office Action’s contention is respectfully traversed.

With regard to the present rejection under 35 U.S.C. 103, it is respectfully submitted that the Office Action has not made a *prima facie* case of obviousness, as required by the United States Supreme Court and MPEP § 2143.

MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation** of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made **explicit**” (emphasis added).

While citations to sections of the cited art (e.g., Chen, paragraphs 20, 31 and 32) were appended to the end of the claimed features (which were conceded by the Examiner as not being described by Brinkley) that were rejected in the Office Action at page 4, no reasoning was provided as to why the cited sections were believed to teach these features. As such, the rejections are merely conclusory assertions.

Citations alone, in the absence of associated reasoning, are insufficient support for a rejection as an Office Action lacking such reasoning does not provide a reader with insight into **why** the Examiner rejected the claimed features. Rather, the reader is left to draw his or her own conclusions as to why the claims were rejected. Because the present rejection over at least the aforementioned features of claim 1 of the present application lack a clear articulation of the reasons why the features recited in the claims would allegedly have been obvious in light of the

cited art, the rejection cannot be supported per the requirements set forth by the United States Supreme Court. As such, the record in the current case is incomplete and the rejection is improper.

If the Examiner is to maintain the present rejection, they are requested to more particularly point out which elements in the cited portions of paragraphs 20, 31 and 32 of Chen correlate with the aforementioned features of claim 1 of the present application.

Further, the Examiner is respectfully reminded that not only is such a request statutorily required (as indicated in the MPEP above), but also furthers the USPTO's articulated policy of **Compact Prosecution** as evidenced by MPEP 2106:

"It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application."

In view of the foregoing, it is submitted that the asserted art, either alone or in combination, fails to teach or suggest at least the aforementioned recitations of claim 1 of the present application.

(B) The Office Action contends at page 3, “a price inputting means for inputting a price of the parts (order cost ... user-specified input parameters, col. 9, lines 1-9).” The Office Action’s contention is respectfully traversed.

As a non-limiting example, the Specification of the present application states at page 13, lines 12-15:

“A keyboard (inputting means) 12a is connected to the host computer 12, and the price, size, and lead time of the individual parts are inputted or entered via the keyboard 12a. The inputted price, size, and lead time of the parts are stored in a part information database 70.”

Furthermore, regarding means-plus-function recitations, it is stated in MPEP § 2181(II) that:

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure described in the specification and equivalents thereof.” “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language...”

In contrast to the aforementioned recitation of claim 1 and included portion of the Specification of the present application, it is submitted that in the cited portion of Brinkley, it is stated that the “MISER program 250 stratifies the portfolio based on three criteria: order cost, volume of orders, and number of orders.” Accordingly, it is submitted that “price data inputting means for inputting a price data of the parts” is not described in the cited portion; but instead, a

stratification of the portfolio is performed based on the aforementioned criteria (e.g., order cost, volume of orders and number of orders).

The Examiner is respectfully reminded that all recitations of a claim must be considered in furthering a patentability determination, and further, the Examiner must look to the Specification regarding corresponding structure related to a recitation expressed in means-plus-function form.

(C) On page 3 of the outstanding Office Action, the Office Action contends, “Brinkley discloses ... selecting means for comparing the inputted price with the stored prescribed price and for selecting the first part order quantity computing means when the inputted price is greater than the stored prescribed price, while for selecting the second part order quantity computing means when the inputted price is equal to or less than the prescribed price (col. 10, lines 12-25; col. 11, lines 47-65; col. 12, lines 37-43).” The Office Action’s contention is respectfully traversed.

Firstly, it is unclear how it can be asserted that Brinkley describes the “first part order quantity computing means” and the “second part order quantity computing means” of claim 1 of the present application when the Examiner expressly concedes on the same page of the Office Action that Brinkley does not describe the aforementioned features of claim 1 of the present application?

However, notwithstanding the aforementioned deficiency of the Office Action, it is still submitted that Brinkley does not describe the selecting means of claim 1 of the present application.

It is submitted that the cited art fails to teach or suggest, either alone or in combination, at least the recitation of claim 1 of the present application of, “selecting means for comparing the inputted price data with the stored standard price data...”

As a non-limiting example, FIG. 2 illustrates at S14, “Part Price > Prescribed Price.” Further, as a non-limiting example, the aforementioned recitation of claim 1 of the present application corresponds with the aforementioned illustrative portion of FIG. 2. Additionally, an another non-limiting example, the Specification states at page 14, lines 10-16:

“Then in S14, it is determined whether **the price of the parts (a group of parts) stored in the parts information database 70 exceeds the corresponding prescribed price stored in the prescribed value database 72** (according to the computation selection program 74). The price of the parts (a group of parts) referred to herein is a unit price per lot, for example, and the price may be a fixed price, or may be a variable price that varies depending on the number of lots ordered. The processing after S14 is performed for each group of parts.”

Furthermore, regarding the above bolded portions of the Specification, the Examiner is further directed, as a non-limiting example, toward page 18, line 25-29 which states:

“Thus, in the first embodiment, it is configured such that, **two different part order quantity computation techniques are selected to be used on the basis of the price of**

the parts, it becomes easier to modify the part order quantity computation technique in response to the price of the parts, thereby enabling to effectively obtain the advantages of two different part order quantity computation techniques.”

Although the Office Action does not particularly point out which specific element of Brinkley correlates with the selecting means of claim 1 of the present application, it is assumed that the Examiner intended to correlate the MISER program 250 with the selecting means of claim 1 of the present application.

In at least the cited portions of Brinkley, the MISER program 250 is described as performing the following checks: a) Average Order Cost > costlimit; b) Cost/Volume > maglimit; or c) Number of Orders > ordlimit. Further, the cited portions of Brinkley describe: the **Average Order Cost** as the total dollar sales for the total period surveyed divided by the total number of orders for the item during that period, the **Cost/Volume** as the unit cost of the item divided by the total demand, and the **Number of Orders** as the number of orders of an item. Accordingly, “the inputted price” is not described in Brinkley; but instead, various calculations are performed to obtain the above bolded items.

Thus, in contrast to the aforementioned recitation of claim 1 of the present application and corresponding portions of the Specification of the present application, it is clear that the correlated features of Brinkley (e.g., Average Order Cost, Cost/Volume and Number of Orders) do not relate to that of the claimed feature of “the inputted price” of claim 1 of the present application. It is submitted that a person of ordinary skill in the art would understand that

“inputted price” is “a price of the parts.” As stated above, the included portion of the Specification states that, **“the price of the parts (a group of parts) referred to herein is a unit price per lot, for example, and the price may be a fixed price, or may be a variable price that varies depending on the number of lots ordered.”**

In view of the foregoing, it is respectfully submitted that the rejection is overcome.

Next Office Action Cannot Be Made Final

Applicants respectfully note that at least because the Office Action failed to establish a *prima facie* case of obviousness as described above in Section (A), any rejections in a subsequent Office Action providing adequate reasoning would be presented for the first time on the record and as such, a next Action **cannot** be made final. If the Examiner does not agree to make the next Office Action non-final, they are respectfully requested to provide this paper in its entirety to their Supervisor for review.

Application No.: 10/528,274
Art Unit: 3627

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 052264

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

/Joseph W. Iskra/

Joseph W. Iskra
Attorney for Applicants
Registration No. 57,485
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

JWI/ar